



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,478	04/15/2004	Jean-Yves Legendre	239209US26	6516

22850 7590 04/11/2007
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

WALCZAK, DAVID J

ART UNIT	PAPER NUMBER
----------	--------------

3751

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/11/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/11/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/824,478

Applicant(s)

LEGENDRE, JEAN-YVES

Examiner

David J. Walczak

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-13, 15, 19, 20, 23, 29, 30, 34, 35, 37, 39, 46, 48, 54 and 61-67 is/are rejected.
- 7) ☒ Claim(s) 60 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5-7, 14, 16-18, 21, 22, 24-28, 31-33, 36, 38, 40-45, 47, 49-53 and 55-59.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-10, 13, 19, 29, 30, 34, 35, 37, 46, 48, 54 and 61-65 remain rejected under 35 U.S.C. 102(b) as being anticipated by Spector. In regard to claims 1-4, Spector discloses an applicator comprised of a reservoir 13 having a first side adjacent a user's finger and a second side, a ring 10 for attaching the device to a finger, an applicator portion 17 having a first surface configured to engage a portion of a body during use and a second surface secured to the second side of the reservoir (at the ends thereof, see Figures 1 and 2) located immediately adjacent the second surface of the applicator portion and a breakable membrane 15 to establish communication between the reservoir and applicator wherein the applicator portion is permeable to the product 14. In regard to claims 8 and 9, the first side of the reservoir is deformable in response to external pressure (see column 4, lines 1-5). In regard to claims 10 and 13, the applicator portion includes a porous material 17 (which is resiliently deformable). In regard to claim 19, the applicator portion has a "flattened" shape and the first side of the reservoir is substantially parallel to the face of the applicator portion. In regard to claim 29, since the Spector device is used to remove plaque from the teeth via hydrogen

Art Unit: 3751

peroxide, and thereby render the teeth more attractive, the product can be considered both a "cosmetic" and a "disinfectant". In regard to claim 30, the applicator is attached to a single finger. In regard to claims 34, 35, 37, 46 and 48, as discussed above, the Spector device includes the claimed structure. In regard to claim 54, the first surface of the reservoir has a concave shape when depressed by a finger. In regard to claims 61-63 the applicator portion covers an opening in the membrane such that the product flows through the broken membrane and passes through the applicator to an application surface thereof. In regard to claims 64 and 65, as discussed above, the claimed structure is met by the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8, 9, 10, 12, 13, 19, 20, 29, 30, 34, 35, 37, 46, 48, 54, 61-65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laub in view of Schuck. In regard to claim 1, Laub discloses an applicator for the application of a product comprised of a reservoir 10 having first and second opposing sides with a first side facing a finger when the applicator is mounted on a finger, means 18 to attach the applicator to a finger, an applicator portion 25 having a first surface configured to engage a portion of a body during use and a second surface secured to the second side

of the reservoir located immediately adjacent the second surface of the applicator portion and being isolated from the reservoir prior to a first usage of the device and means 29 to establish communication between the reservoir and the applicator in response to an operating action during the first use of the device. Although the product does not permeate through the applicator as claimed, attention is directed to the Schuck reference, which discloses another toothbrush wherein the applicator (through which the product flows) can be either bristles 104 or a sponge 120 (through which the material permeates) in order to enable a user to employ a sponge to apply product to the oral cavity. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the bristles in the Laub device can be replaced with a sponge (through which the product can permeate) in order to enable a user to employ a sponge to apply product to the oral cavity. In regard to claim 2, the means to attach the applicator includes a finger stall 18. In regard to claims 3 and 4, the means to establish communication includes a membrane 29 which breaks in response to pressure exerted on the first side of the reservoir. In regard to claims 8 and 9, the first side of the reservoir is deformable to thereby establish the communication (see page 2, lines 32-35). In regard to claim 11 the thread-like elements that define the applicator portion 25 (see page 2, lines 13-16) define a "fibrous material". In regard to claim 10, the sponge applicator constitutes a porous material. In regard to claim 12, the applicator includes a sponge material. In regard to claim 13, the applicator portion 25 is made from a "resiliently deformable" material. In regard to claim 19, the first side of the reservoir is parallel to the face of the applicator (see Figure 2). In regard to claim 20, although the

Art Unit: 3751

front of the applicator portion does not have a circular shape, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that that applicator portion can be designed to have any suitable shape, including the claimed shape, without effecting the overall operation of the device. In regard to claim 29, the toothpaste in the reservoir is considered a "cosmetic" in that it improves the appearance of the teeth. In regard to claim 30, the applicator is attached to a single finger via attachment means 18. In regard to claims 34, 35, 46 and 48, as discussed supra, the Laub device includes an cosmetic applicator attached to a single finger and comprised of a reservoir, applicator portion, attachment arrangement and a breakable membrane to establish communication as claimed. In regard to claim 37, the reservoir is positioned between the finger and the applicator. In regard to claim 54, the first surface of the reservoir has a convex shape (see Figure 5). In regard to claims 61-63 the sponge applicator would cover an opening in the membrane such that the product would flow through the broken membrane and pass through the applicator to an application surface thereof. In regard to claims 64 and 65, as discussed above, the claimed structure is met by the prior art. In regard to claim 66, the second surface of the applicator portion and the membrane have a length and are in contact with each other over "substantially" all of their length (see page 2, lines 27)

Claims 15, 23 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laub in view of Schuck, as applied above, and further in view of MacDonald. Although the Laub device employs a finger stall to attach the device to a finger, and not an adhesive with a removable film, attention is directed to the MacDonald reference,

which discloses another finger attached toothbrush wherein an adhesive 16 protected by a removable film 22 is employed to attach the device to a finger. Such an arrangement renders the device to be easily packaged and opened (see column 1, lines 1-22). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such an adhesive (which obviously would be hypoallergenic since it is to be placed in a users mouth) to attach the Laub device to a finger (as opposed to the stall) in order to render that device to be easily packaged and opened.

Claims 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector. In regard to claim 11, although the Spector reference does not disclose that the applicator portion is made from a fibrous material, the Examiner takes official notice that such porous applicator are commonly made from fibrous materials (i.e., cotton swabs or felt tips) in order to effectively transfer the product. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the applicator portion in the Spector device can be made from such a fibrous material in order to effectively transfer the product. In regard to claim 20, although the front of the applicator portion does not have a circular shape, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that that applicator portion can be designed to have any suitable shape, including the claimed shape, without effecting the overall operation of the device.

Claims 15, 23, 39 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector in view MacDonald. Although the Spector device employs a

finger stall to attach the device to a finger, and not an adhesive with a removable film, attention is directed to the MacDonald reference, which discloses another finger attached toothbrush wherein an adhesive 16 protected by a removable film 22 is employed to attach the device to a finger. Such an arrangement renders the device to be easily packaged and opened (see column 1, lines 1-22). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such an adhesive (which obviously would be hypoallergenic since it is to be placed in a users mouth) to attach the Spector device to a finger (as opposed to the stall) in order to render that device to be easily packaged and opened.

Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laub in view of MacDonald. As discussed supra, Laub discloses a reservoir, applicator and a means to establish communication between the reservoir and applicator. Although the Laub device employs a finger stall to attach the device to a finger, and not an adhesive with a removable film, attention is directed to the MacDonald reference, which discloses another finger attached toothbrush wherein an adhesive 16 protected by a removable film 22 is employed to attach the device to a finger. Such an arrangement renders the device to be easily packaged and opened (see column 1, lines 1-22). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such an adhesive (as opposed to the stall) in order to render that device to be easily packaged and opened.

Allowable Subject Matter

Claim 60 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

The Applicant contends that the Spector reference is not applicable in that it does not disclose an applicator having a second surface secured to the second side of the reservoir located immediately adjacent to the second surface of the applicator. Viewing Figure 1 of Spector, however (and as discussed above) the peripheral portion of applicator 17 defines a second surface of the applicator that is secured to the second side of the reservoir located immediately adjacent the second surface of the applicator.

The Applicant further contends that the above discussed combination of the Laub and Schuck references is improper as it constitutes hindsight reconstruction. In response this argument, the Examiner contends that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, as the Laub and Schuck references are both toothbrushes wherein

Art Unit: 3751

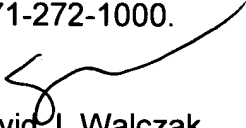
material is dispensed to the applicator, and the Schuck reference clearly discloses that the applicator of the toothbrush can be either bristles or a sponge, the Examiner maintains that one of ordinary skill in the art at the time the invention was made would readily recognize, after reviewing these references, that the applicator portion of the Laub device can be either bristles or a sponge, regardless of how the material is dispensed. No knowledge of the Applicant's disclosure is needed to reach such a conclusion as the references disclose all of the claimed elements.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huşon Gregory can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
3/27/07